

REMARKS/ARGUMENTS

Reconsideration of this application is requested. Claims 1-15 remain in the application subsequent to entry of this Amendment.

Claim 16 has been canceled as being non-statutory and claims 17 and 18 have been canceled as directed to non-elected subject matter. This action is taken without disclaimer or prejudice to a divisional application or applications directed to the subject matter of claim 17 and/or 18.

The sole issue presented is the patentability of claims 1-15 over the disclosures of Greenberg et al U.S. patent publication 2005/0153407. The Official Action indicates that for the involved subject matter the effective date is “September 22, 2002” when in fact the face of the ‘407 publication shows the correct date to be September 20, 2002 for provisional application 60/412,625. The Official Action draws attention to Figure 6, Route A and page 8, paragraph [0046] of the ‘625 provisional application. Corresponding information is found in Figure 10 and paragraph [0151] of the ‘407 published application.

The crux of the Official Action is the single sentence at the top of page 3 “Although the specific solvent and lowering of pH are not taught (in the documents discussed above) these simple modifications are well known to the person of ordinary skill in the art”. Applicants dispute this conclusion as it is not based upon any document of record in this application but instead is a conclusion reached without benefit of supporting information.

Applicants submit the use of water as solvent, as claimed in claim 1 of the subject application, is inventive because there are no documents that suggest the use of this solvent, which in the end of course is the solvent of choice from an environmentally friendly point of view. If it was such a simple modification as the examiner suggests, certainly somebody would have tried it.

Similarly, the examiner argues that lowering the pH is a “simple” modification and apparently concludes that therefore that this aspect of the claim is “obvious” and not patentable. Perhaps changing a solvent or lowering a pH is, as such, a simple modification, but lack of inventivity is not governed by the simplicity of a measure but by the obviousness to take that specific measure.

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Appl. No. 10/554,294
April 9, 2008

With some inventions such as the present one, a very slight difference – shift in the angle of entry – can greatly distinguish the invention from the prior art and greatly advance the scientific field. *See Eibel Process Co. v Minn. & Ontario Paper Co.*, 261 U.S. 45 (1923).

There are no indications whatsoever given by the examiner or the 60/412,625 document or U.S. 2005/0153,407 that would render the subject matter of claim 1 more specifically the use of water and/or the specific pH regime, obvious.

In addition, the examiner points to page 8, paragraph [0046] of 60/412,625 to support the assertion that changing to water as solvent and lowering of the pH are indeed to be considered “simple modifications” but this is not disclosed in that passage; the passage only describes the general conversion of the halomethyl lactone into the cyanomethyl lactone.

For the above reasons it is respectfully submitted that the claims of this application define inventive subject matter. Reconsideration and allowance are solicited. Should the examiner require further information, please contact the undersigned.

Respectfully submitted,

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